

IFW AF/2127

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/628,367	
	Filing Date	July 31, 2000	
	First Named Inventor	Bailey et al.	
	Art Unit	2127	
	Examiner Name	Nilesh R. Shah	
Total Number of Pages in This Submission	12	Attorney Docket Number	GB9-2000-0083-US1

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Firm or Individual name	Winstead Sechrest & Minick P.C. Robert A. Voigt, Jr. Reg. No. 47,189	
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- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Before the Examiner:
Michael C. Bailey et al.	:	Shah, Nilesh R.
Serial No.: 09/628,367	:	Group Art Unit: 2127
Filed: July 31, 2000	:	
Title: METHOD, PROGRAM PRODUCT	:	IBM Corporation
AND COMPUTER SYSTEM FOR	:	P.O. Box 12195
PROGRESSIVE IMPROVEMENT	:	Dept. T81/503
OF AN ENVIRONMENT POOL	:	Research Triangle Park, NC 27709

REQUEST FOR REINSTATEMENT OF APPEAL

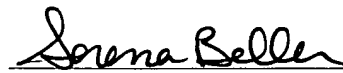
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 Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action (Paper No. 9) having a mailing date of August 26, 2004, reopening prosecution of the above-referenced Application, Applicants respectfully request reinstatement of the Appeal based on the Appeal Brief filed on May 19, 2004 and the Notice of Appeal filed on April 22, 2004.

CERTIFICATION UNDER 37 C.F.R. §1.8

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Serena Beller
 (Printed name of person certifying)

A supplemental appeal brief is filed herewith.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 09-0461 (GB9-2000-0083-US1).

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 09-0461 (GB9-2000-0083-US1).

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

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GB9-2000-0083-US1

PATENT

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Michael C. Bailey et al.	:	Shah, Nilesh R.
Serial No.: 09/628,367	:	Group Art Unit: 2127
Filed: July 31, 2000	:	
	:	
Title: METHOD, PROGRAM PRODUCT	:	IBM Corporation
AND COMPUTER SYSTEM FOR	:	P.O. Box 12195
PROGRESSIVE IMPROVEMENT	:	Dept. T81/503
OF AN ENVIRONMENT POOL	:	Research Triangle Park, NC 27709

SUPPLEMENTAL APPEAL BRIEF

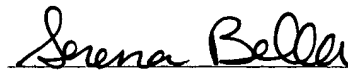
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Dear Sir:

This supplemental brief is being submitted pursuant to 37 C.F.R. §41.37.

CERTIFICATION UNDER 37 C.F.R. §1.8

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Signature

Serena Beller

(Printed name of person certifying)

I. INCORPORATION BY REFERENCE

Appellants hereby incorporate herein by reference Sections I-V and VIII-IX of Appellants' Brief mailed on May 19, 2004.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-18 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis et al. (U.S. Patent No. 5,896,531) (hereinafter "Curtis") in view of Kaczmariski (U.S. Patent No. 6,448,981).

IV. ADDITIONAL ARGUMENTA. Claims 1-18 are not properly rejected under 35 U.S.C. §112, second paragraph.

The Examiner has rejected claims 1-18 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which Applicants regard as the invention. Paper No. 9, page 2. In particular, the Examiner states:

- i. As per claims 1 and 11 (line 1) the 'pool of reusable environments' is indefinite because it is not made explicitly clear in the claim language if the new environments come from the pool of reusable environments or are they created differently?
- ii. As per claims 1 and 11 (lines 5-12) the 'best' is indefinite because it is not made explicitly clear in the claim language if the best environment is determined by the user or the program running. Also is the best environment for the first program or second program?
- iii. As per claims 1 and 11 (lines 10-12) the 'requirements' is indefinite because it is not made explicitly clear in the claim language if the requirements is determined by the user, application or the program. Finally, where is the requirements stored and how are they compared to determine if a match exists? Paper No. 9, page 3.

Appellants respectfully traverse these rejections for at least the reasons stated below.

Appellants respectfully assert that the phrase "pool of reusable environments", as recited in claims 1 and 11, can be determined by one having ordinary skill in the art. As stated above, the Examiner asserts that the phrase "pool of reusable environments" is indefinite because it is not made explicitly clear in the claim language if the new environments come from the pool of reusable environments or if they are created differently. The purpose of a claim is not to explain technology or how it works. *S3 Inc. v. nVIDIA Corp.*, 59 U.S.P.Q.2d 1745, 1478 (Fed. Cir. 2001). The purpose is to state the legal boundaries of the patent grant. *Id.* Hence, there is no requirement to explain whether new environments are created from a pool of reusable environments or elsewhere. Instead, in determining whether a claim is in compliance with 35 U.S.C. §112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope, and therefore, serves the notice function required by 35 U.S.C. §112, second paragraph. M.P.E.P. §2173.02. That is, the basis of a 35 U.S.C. §112, second paragraph, rejection is whether the scope of the claimed subject matter cannot be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d).

Appellants respectfully assert the phrase "pool of reusable environments" can be determined by one having ordinary skill in the art. Appellants kindly direct the Board's attention to page 9, line 4 – page 10, line 7 of the Specification, which describes, in part, a memory that includes a pool of resources that includes both preinitialized environments and a new environment. The cited passage in the Specification further describes a dispatcher that may be programmed to offer preinitialized environments for reuse by any second or subsequent program. The cited passage in the Specification further describes that the dispatcher is able to accept an altruistic role so long as there is room in the pool for a new environment. Appellants also kindly direct the Board's attention to page 11, lines 1-23 of the Specification, which describes, in part, that the dispatcher may create a new

environment if there are no preinitialized environments that match the required parameter elements and cause the required parameter elements to be added to the new environment. Hence, the Specification describes a pool that includes preinitialized environments that may be reused. Further, the Specification describes a pool that may further include a new environment that may be created if there are no preinitialized environments that match the required parameter elements. It is noted that this interpretation is illustrative and that Appellants are not limited to this interpretation. A rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d). One having ordinary skill in the art can determine the scope of the claimed subject matter, including the phrase "pool of reusable environments." Consequently, Appellants respectfully assert that claims 1-18 are allowable under 35 U.S.C. §112, second paragraph.

Appellants further assert that the phrase "responsive to a determination that creation of a new environment is a best response", as recited in claims 1 and 11, can be determined by one having ordinary skill in the art. As stated above, the Examiner asserts that the phrase "best" is indefinite because it is not made explicitly clear in the claim language if the best environment is determined by the user or the program running. The Examiner further states that "best" is indefinite because it is not made explicitly clear in the claim language if the best environment is for the first program or second program. As stated above, the purpose of a claim is not to explain technology or how it works. *S3 Inc. v. nVIDIA Corp.*, 59 U.S.P.Q.2d 1745, 1478 (Fed. Cir. 2001). The purpose is to state the legal boundaries of the patent grant. *Id.* Hence, there is no requirement to explain whether the best environment is determined by the user or the program running. Neither is there a requirement to explain whether the best environment is for the first or second program. Instead, in determining whether a claim is in compliance with 35 U.S.C. §112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope, and therefore, serves the notice function

required by 35 U.S.C. §112, second paragraph. M.P.E.P. §2173.02. That is, the basis of a 35 U.S.C. §112, second paragraph, rejection is whether the scope of the claimed subject matter cannot be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d).

Appellants respectfully assert the phrase "responsive to a determination that creation of a new environment is a best response" can be determined by one having ordinary skill in the art. Appellants kindly direct the Board's attention to page 11, lines 1-17 of the Specification, which describes, in part, a dispatcher that determines if the required parameter elements match a free environment. The cited passage in the Specification further describes that if the required parameter elements do not match a free environment, then the dispatcher determines whether the best response is to create a new environment. The cited passage in the Specification further describes that the determination may be based on a maximum size setting for the environment pool. The cited passage in the Specification further describes that if the maximum size has been reached, it may be the best response to attempt to locate a nearly-matching preinitialized environment. Hence, the Specification describes a dispatcher determining whether the best response is to create a new environment when the required parameter elements do not match a free environment. In one embodiment, the dispatcher may determine if it is the best response to create a new environment based on a maximum size setting for the environment pool. It is noted that this interpretation is illustrative and that Appellants are not limited to this interpretation. As stated above, a rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d). One having ordinary skill in the art can determine the scope of the claimed subject matter, including the phrase "responsive to a determination that creation of a new environment is a best response." Consequently, Appellants respectfully assert that claims 1-18 are allowable under 35 U.S.C. §112, second paragraph.

Appellants further assert that the phrase "adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program", as recited in claims 1 and 11, can be determined by one having ordinary skill in the art. As stated above, the Examiner asserts that the phrase "requirements" is indefinite because it is not made explicitly clear in the claim language if the requirements are determined by the user, application or the program. The Examiner further states that the phrase "requirements" is indefinite because it is not made explicitly clear in the claim language where the requirements are stored and how are they compared to determine if a match exists. As stated above, the purpose of a claim is not to explain technology or how it works. *S3 Inc. v. nVIDIA Corp.*, 59 U.S.P.Q.2d 1745, 1478 (Fed. Cir. 2001). The purpose is to state the legal boundaries of the patent grant. *Id.* Hence, there is no requirement to explain whether the requirements are determined by the user, application or the program. Neither is there a requirement to explain where the requirements are stored and how are they compared to determine if a match exists. Instead, in determining whether a claim is in compliance with 35 U.S.C. §112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope, and therefore, serves the notice function required by 35 U.S.C. §112, second paragraph. M.P.E.P. §2173.02. That is, the basis of a 35 U.S.C. §112, second paragraph, rejection is whether the scope of the claimed subject matter cannot be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d).

Appellants respectfully assert the phrase "adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program" can be determined by one having ordinary skill in the art. Appellants kindly direct the Board's attention to page 11, lines 19-22; and page 12, lines 4-9 and 11-17 of the Specification, which describes, in part, that the dispatcher causes the required parameter elements to be added to either a newly created environment, a free

environment lacking the required parameter elements or a free environment from another pool, if those required parameter elements do not match a free environment. Appellants further direct the Board's attention to page 11, lines 1-7 of the Specification, which describes, in part, that a program is initiated. The cited passage in the Specification further describes the dispatcher determining if there is match between the starting parameter elements and a free environment. The cited passage in the Specification further describes that the dispatcher will use the free environment which matches the parameter elements of the program. Hence, the Specification describes adding parameter elements to an environment, e.g., newly created environment, free environment, where those elements are required by a program, if there is not a free environment which matches the required parameter elements. If there is a free environment which matches the required parameter elements, then the free environment will be used. It is noted that this interpretation is illustrative and that Appellants are not limited to this interpretation. As stated above, a rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d). One having ordinary skill in the art can determine the scope of the claimed subject matter, including the phrase "adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program." Consequently, Appellants respectfully assert that claims 1-18 are allowable under 35 U.S.C. §112, second paragraph.

B. Claims 1-18 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis in view of Kaczmariski.

The Examiner has rejected claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over Curtis in view of Kaczmariski. Paper No. 9, page 4. The rejections to claims 1-18 under 35 U.S.C. §103(a) are moot for the reasons stated below.

References Curtis and Kaczmariski, which may both qualify as prior art under 35 U.S.C. § 102(e), cannot preclude patentability under 35 U.S.C. § 103 since either Curtis or Kaczmariski and the claimed invention in claims 1-18 were at the time the invention was made, subject to an obligation of assignment to the same person, which in this case was International Business Machines, Inc. 35 U.S.C. §103(c). Thus, both Curtis and Kaczmariski are disqualified as being used as a prior art reference under 35 U.S.C. § 103(c). Consequently, the rejections of claims 1-18 under 35 U.S.C. §103(a) are moot.

V. CONCLUSION

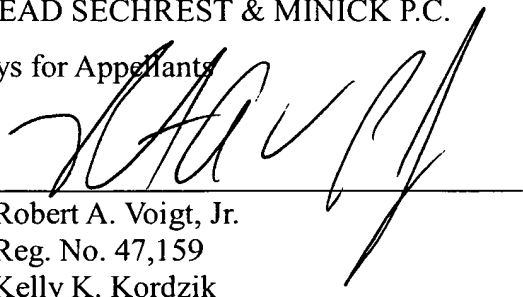
For at least the reasons stated above and in the Appeal Brief filed by Appellants on May 19, 2004, the rejections of claims 1-18 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-18.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

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